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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,618	02/19/2002	J. Barry Shackleford	100110018-1	5631

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EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,618

Applicant(s)

SHACKLEFORD, J. BARRY

Examiner

Joseph R. Maniwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/19/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/03/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the submitted drawings are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 2, reference character 200. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:
4. Recitation of "Data may be delineated be keywords," appears to be a typographical error.
5. Appropriate correction is required.

Claim Objections

6. Claim 1 is objected to because of the following informalities: recitation of "A method for an electronic system user to programming" is not grammatically correct. Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "An electronic system, comprising: means for..." is non-statutory since it is not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement. This is true even if the claimed operations include hardware, since it is the intent of the execution of the system and not the system itself that include such hardware.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 5-7, 10-14, 18-20, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Fleming, III et al. (U.S. Pat. No. 6,625,444), hereinafter referred to as Fleming.

11. Regarding claims 1, 6, 10-12, 18-19, 25, and 26, Fleming disclosed a method and system comprising generating and transmitting an e-mail message including user-selected preference data (see column 4, lines 17-34; column 4, line 60 through column 5, line 2), automatically extracting the user-selected preference data from the message (see column 5, lines 2-5), transmitting the user-selected preference data to an electronic system, and configuring the electronic system with the user-selected preference data (see column 4, lines 32-49). Fleming disclosed the use of a cellular phone (see column 2, lines 54-64), thus disclosing the use of a non-QWERTY user-input device as claimed.

12. Regarding claim 2, Fleming disclosed transmitting the user-selected preference data to the electronic system in response to a request as claimed (see column 2, lines 9-13).

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13. Regarding claims 3, 5, 14, 20, Fleming disclosed user-selected preference data as telephone directory information as claimed (see column 2, lines 3-5; column 4, lines 35-38).

14. Regarding claims 7 and 13, a wireless connection is inherent through the disclosure of a cellular phone (see column 2, lines 54-64).

15. Claims 1, 2, 6, 10-12, 18, 19, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by L'Heureux et al. (U.S. Pat. No. 6,697,942), hereinafter referred to as L'Heureux.

16. Regarding claims 1, 6, 10-12, 18, 19, 25, and 26, L'Heureux disclosed generating an e-mail including user-selected preference data, transmitting the e-mail to a destination (see column 4, line 61 through column 5, line 12), extracting the user-selected preference data from the e-mail, transmitting it to an electronic system, and configuring the electronic system with the user-selected preference data as claimed (see column 8, lines 1-14). L'Heureux further disclosed the use of non-QWERTY keypads as claimed (see column 6, lines 48-52).

17. Regarding claim 2, L'Heureux disclosed transmitting the user-selected preference data to the electronic system in response to a request as claimed (see column 5, lines 13-15).

Claim Rejections - 35 USC § 103

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18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 4, 8, 9, 15-17, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming, III et al. (U.S. Pat. No. 6,625,444), hereinafter referred to as Fleming, and further in view of Brown et al. (U.S. Pat. App. Pub. 2003/0061288), hereinafter referred to as Brown.

20. Fleming disclosed a method and system comprising generating and transmitting an e-mail message including user-selected preference data (see column 4, lines 17-34; column 4, line 60 through column 5, line 2), automatically extracting the user-selected preference data from the message (see column 5, lines 2-5), transmitting the user-selected preference data to an electronic system, and configuring the electronic system with the user-selected preference data (see column 4, lines 32-49). Fleming disclosed the use of a cellular phone (see column 2, lines 54-64).

21. While Fleming disclosed the use of a cellular phone, Fleming did not specifically disclose the use of a television signal recorder as claimed.

22. In a related art of e-mail communication, Brown disclosed a method and system for providing e-mail message to a client device. The invention of Brown was similar to that of Fleming in that it provided a way to deliver e-mail messages to a client including user-selected preference data for configuring the client system (see paragraph [0011]).

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Most importantly, Brown disclosed that a client device receiving e-mail messages included a set top box (see paragraph [0020]).

23. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Fleming and Brown to provide a system for generating and transmitting e-mail messages including user-selected preference data to a client device, and configuring the client device according to the user-selected preference data, the client device further including a set top box as claimed. The invention of Fleming sought to provide programming functionality to devices with difficult manual programming capabilities (see column 1, lines 41-67). In other words, Fleming's disclosed programming system provided greater accessibility to client devices. One of ordinary skill in the art would then be motivated to combine the teachings of Fleming and Brown as Brown similarly sought to provide greater accessibility features to a wide range of client devices (see paragraphs [0009]-[0011]), thus increasing the universality of functions such as e-mail to client devices.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bates et al. (U.S. Pat. No. 6,769,015) disclosed a method of providing presentation information in an e-mail hyperlink.

Eggleston et al. (U.S. Pat. No. 6,101,531) disclosed a system for filtering data transferred to a wireless client based on user-selected criteria filter.

Gilbert (U.S. Pat. No. 6,529,942) disclosed a method and system for providing recipient specific formats for e-mail.

Kaghazian (U.S. Pat. No. 6,563,913) disclosed a system for sending e-mail to a handheld device prepared in a user-selected format.

Gough (U.S. Pat. No. 6,704,771) disclosed a method and system for communicating e-mail messages containing payload data for initializing applications.

Mousseau et al. (U.S. Pat. No. 6,779,019) disclosed a method and system for pushing information from a host system to a mobile device.

Raghunandan (U.S. Pat. No. 6,832,244) disclosed a graphical email content analyzer for classifying e-mail messages.

Brown et al. (U.S. Pat. App. Pub. 2002/0078158) disclosed an e-mail messaging system for delivering of enhanced rich media.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A. Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


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